

PATENT COOPERATION TREATY

From the
INTERNATIONAL PRELIMINARY EXAMINING AUTHORITY

To: SEAN S. WOODEN
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PCT

WRITTEN OPINION

(PCT Rule 66)

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|---|--|
| Date of Mailing (day/month/year) 02 NOV 2001 | |
| Applicant's or agent's file reference 5283.01 | REPLY DUE within TWO months from the above date of mailing |
| International application No. PCT/US00/25826 | International filing date (day/month/year) 21 SEPTEMBER 2000 |
| Priority date (day/month/year) 21 SEPTEMBER 1999 | |
| International Patent Classification (IPC) or both national classification and IPC IPC(7): H04N 7/173 and US Cl.: 725/31 | |
| Applicant DISCOVERY COMMUNICATIONS, INC. | |

1. This written opinion is the first (first, etc.) drawn by this International Preliminary Examining Authority.

2. This opinion contains indications relating to the following items:

- I ☒ Basis of the opinion
- II ☐ Priority
- III ☐ Non-establishment of opinion with regard to novelty, inventive step or industrial applicability
- IV ☐ Lack of unity of invention
- V ☒ Reasoned statement under Rule 66.2(a)(ii) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement
- VI ☒ Certain documents cited
- VII ☐ Certain defects in the international application
- VIII ☐ Certain observations on the international application

3. The applicant is hereby invited to reply to this opinion.

When? See the time limit indicated above. ~~The applicant may, before the expiration of that time limit, request this Authority to grant an extension, see Rule 66.2(d).~~

How? By submitting a written reply, accompanied, where appropriate, by amendments, according to Rule 66.3. For the form and the language of the amendments, see Rules 66.8 and 66.9.

Also For an additional opportunity to submit amendments, see Rule 66.4.
For the examiner's obligation to consider amendments and/or arguments, see Rule 66.4 bis.
For an informal communication with the examiner, see Rule 66.6.

If no reply is filed, the international preliminary examination report will be established on the basis of this opinion.

4. The final date by which the international preliminary examination report must be established according to Rule 69.2 is: 21 JANUARY 2002

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|--|--|
| Name and mailing address of the IPEA/US Commissioner of Patents and Trademarks Box PCT Washington, D.C. 20231 | Authorized officer CHRISTOPHER GRANT |
| Facsimile No. (703) 305-3230 | Telephone No. (703) 305-4755 |

WRITTEN OPINION

International application No.

PCT/US00/25826

I. Basis of the opinion

1. With regard to the elements of the international application:*

☒ the international application as originally filed

☒ the description:

pages 1-110, as originally filed
pages NONE, filed with the demand
pages NONE, filed with the letter of

☒ the claims:

pages 111-140, as originally filed
pages NONE, as amended (together with any statement) under Article 19
pages NONE, filed with the demand
pages NONE, filed with the letter of

☒ the drawings:

pages 1-55, as originally filed
pages NONE, filed with the demand
pages NONE, filed with the letter of

☒ the sequence listing part of the description:

pages NONE, as originally filed
pages NONE, filed with the demand
pages NONE, filed with the letter of

2. With regard to the language, all the elements marked above were available or furnished to this Authority in the language in which the international application was filed, unless otherwise indicated under this item.

These elements were available or furnished to this Authority in the following language which is:

- ☐ the language of a translation furnished for the purposes of international search (under Rule 23.1(b)).
☐ the language of publication of the international application (under Rule 48.3(b)).
☐ the language of the translation furnished for the purposes of international preliminary examination (under Rules 55.2 and/or 55.3).

3. With regard to any nucleotide and/or amino acid sequence disclosed in the international application, the written opinion was drawn on the basis of the sequence listing:

- ☐ contained in the international application in printed form.
☐ filed together with the international application in computer readable form.
☐ furnished subsequently to this Authority in written form.
☐ furnished subsequently to this Authority in computer readable form.
☐ The statement that the subsequently furnished written sequence listing does not go beyond the disclosure in the international application as filed has been furnished.
☐ The statement that the information recorded in computer readable form is identical to the written sequence listing has been furnished.

4. ☒ The amendments have resulted in the cancellation of:

☒ the description, pages NONE
☒ the claims, Nos. NONE
☒ the drawings, sheets/fig NONE

5. ☐ This opinion has been drawn as if (some of) the amendments had not been made, since they have been considered to go beyond the disclosure as filed, as indicated in the Supplemental Box (Rule 70.2(c)).

* Replacement sheets which have been furnished to the receiving Office in response to an invitation under Article 14 are referred to in this opinion as "originally filed".

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V. Reasoned statement under Rule 66.2(a)(ii) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement

1. statement

| | | | |
|-------------------------------|--------|--------------|-----|
| Novelty (N) | Claims | <u>1-189</u> | YES |
| | Claims | <u>NONE</u> | NO |
| Inventive Step (IS) | Claims | <u>NONE</u> | YES |
| | Claims | <u>1-189</u> | NO |
| Industrial Applicability (IA) | Claims | <u>1-189</u> | YES |
| | Claims | <u>NONE</u> | NO |

2. citations and explanations

Claims 1-189 lack an inventive step under PCT Article 33(3) as being obvious over Hendricks (WO 95 15649) in view of Barney et al. (US 5,341,426).

Considering claims 1, 130 and 144, Hendricks discloses a method and corresponding apparatus for encrypting electronic books for delivery between two or more parties and comprising:

- a) supplying electronic book (pages 6-8);
- b) supplying encrypted electronic book (see the entire document including but not limited to page 8, lines 32-34, page 10, lines 9-14, page 11, lines 3-11, figures 3 & 4); and
- c) decrypting the encrypted electronic book (page 19, line 30 and figure 12, step 832).

However, Hendricks fails to specifically disclose encrypting and decrypting keys as recited in the claims.

Barney discloses various types of encryption and decryption keys and techniques for providing secure communication between a central facility and terminals. See the entire document including but not limited to figures 1-3 and the corresponding text.

It would have been obvious to one of ordinary skill in the art to modify Hendricks' system to include encryption and decryption keys, as taught by Barney, for the advantage of providing secure communication between a central facility and terminals.

Claims 2-129, 131-143 and 145-189 are met by the combined systems of Hendricks and Barney, wherein Hendricks discloses the detail features of the electronic book and Barney discloses the details and various types of encryption/decryption techniques.

NEW CITATIONS

WO 95 15649 A (HENDRICKS et al.) 08 June 1995, whole document
US 5,341,426 A (BARNEY et al.) 23 August 1994, figures 1-3

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VI. Certain documents cited

1. Certain published documents (Rule 70.10)

| <u>Application No. Patent No.</u> | <u>Publication Date (day/month/year)</u> | <u>Filing Date (day/month/year)</u> | <u>Priority date (valid claim) (day/month/year)</u> |
|---------------------------------------|--|---|---|
| US 6,052,717 A | 18 APRIL 2000 | 23 OCTOBER 1996 | |
| US 6,034,680 A | 07 MARCH 2000 | 30 APRIL 1997 | 25 APRIL 1997 |

2. Non-written disclosures (Rule 70.9)

| <u>Kind of non-written disclosure</u> | <u>Date of non-written disclosure (day/month/year)</u> | <u>Date of written disclosure referring to non-written disclosure (day/month/year)</u> |
|---------------------------------------|--|--|
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Supplemental Box

(To be used when the space in any of the preceding boxes is not sufficient)

Continuation of: Boxes I - VIII

Sheet 10

TIME LIMIT:

The time limit set for response to a Written Opinion may not be extended. 37 CFR 1.484(d). Any response received after the expiration of the time limit set in the Written Opinion will not be considered in preparing the International Preliminary Examination Report.